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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,685	10/15/2003	Anthony Costa	0299568-0417	7079

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IP Department
Schnader Harrison Segal & Lewis LLP
Suite 3600
1600 Market Street
Philadelphia, PA 19103

EXAMINER

SILVERMAN, ERIC E

ART UNIT	PAPER NUMBER
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1618

MAIL DATE	DELIVERY MODE
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01/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/685,685	Applicant(s) COSTA ET AL.	
	Examiner Eric E. Silverman, PhD	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-10,12-15 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) 18-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-10,12-15 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/30/2007 has been entered.

Applicants' remarks, declaration under CFR 1.132, and amendment, filed 10/30/2007, have been received. Claims 1, 5 – 10, 12 – 15, and 17 – 24 are pending and claims 18 – 24 are withdrawn.

Response to Amendment

The declaration under 37 CFR 1.132 filed 10/30/2007 is sufficient to overcome the rejection of claim 1, 5 – 10, 12 – 15, and 17 – 24 based upon 35 U.S.C. 112, first paragraph, for failing to comply with the enablement requirement.

However, the claim amendments have necessitated the new grounds of rejection discussed below.

Response to Arguments

Applicant's arguments with respect to claims 1, 5 – 10, 12 – 15, and 17 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 5 – 10, 12 – 15, and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is a new matter rejection.**

The instant claims require from “about 36% to about 45%” ethoxydiglycol (claims 1, 5 – 10, 12 – 15) or “36% to 45%” ethoxydiglycol (claim 17). This is new matter, not supported by the originally filed disclosure. Applicants’ response correctly points out that the specification mentions the ranges 32% - 46% and 34% - 46% ethoxydiglycol. However, Applicants’ reliance on *In re Wertheim* (citation omitted) in an attempt show that the original disclosure supports the instantly claimed ranges is misguided; in fact, the instant case clearly distinguishes from *Wertheim*. The *Wertheim* applicants disclosed a range of 25-60% and gave two examples at 36% and 50%. These two examples were important, because they showed that the *Wertheim* applicants favored the upper-end of the range, specifically that from about 35% to about 60%, which was supported. In *Wertheim*, it was the two specific examples *within the finally claimed range* that showed the applicants to be in possession of the smaller range.

In the instant case, the situation is quite different. Applicants cannot rely on specific examples to show possession of the newly claimed range, because no such

example exists in the originally filed disclosure. Instead, Applicants here attempt to rely on the endpoints of ranges, the endpoints being *outside* the range that Applicants now attempt to claim. This is significant for two reasons. First, the endpoints of a range are not disclosed any more specifically than any other point in the range. As such, it is improper to compare the *endpoints* of instant specification with the *specifically disclosed examples* of *Wertheim*. The disclosure of "34% - 45%" is no more a specific disclosure of 34% than it is of 38.5% or 41.546%. The instantly disclosed *endpoints*, being merely two of an infinite number of possibilities within the range, are insufficient to show possession of an *undisclosed* endpoint. Second, even if the endpoints of the ranges "32% - 45%" and "34% - 45%", as disclosed, are analogous to the examples in *Wertheim* in that they are sufficient to support some other endpoint, they are not sufficient to support the now claimed 36% - 45%. In *Wertheim*, the exemplary points were both *within the range* that was ultimately supported. Here, the endpoints relied on are both *outside the claimed range* of 36% - 45%. The disclosed endpoints cannot be reasonably said to provide a description of a range, as Applicants aver, when the endpoints are *not a part of the range* which they are (improperly) alleged to support.

To the extent that *Wertheim* is the most relevant authority to address the case at hand, the instant case is clearly distinguished from *Wertheim* and the claimed range does not find support in the originally filed disclosure.

It is noted that, at item 22 on the declaration filed with the most recent response, declarant, an inventor of instant Application, notes that the originally disclosed ranges of 32% - 45% and 34% - 45% were disclosed in good faith, and it were believed to be

indicative of the workable range of ethoxydiglycol in the invention. The Office, in applying this rejection, is not attempting to imply that Applicants original disclosure was made in bad faith, or that the original disclosure attempted to conceal any aspect of the invention that Applicants were obliged to disclose (such as the best mode for practicing the invention). On the contrary, it is clear from the record that, when the application was filed, Applicants reasonably believed that the disclosed ranges of 32%-45% and 34%-45% were the useful ranges of ethoxydiglycol in the context of the invention. However, good faith does not enter into the inquiry for written description. What appears to have occurred here is that, in response to the (now withdrawn) rejection for lack of enablement, Applicants provided a declaration in an attempt to show that the entire disclosed range of their invention is enabled. Unfortunately, Applicants further investigations actually showed that a portion of the originally disclosed range was in fact not enabled. Applicants amended the claims to exclude the non-enabled portion of the ranges originally claimed. Thus, Applicants declaration, including the undisputed assertion of good faith, is evidence that Applicants did not possess, as of the filing date of the invention, the instantly claimed range. Applicants, acting in good faith, clearly would have disclosed the 36%-45% range at the time of filing if Applicants knew at that time that this was the appropriate working range. However, the fact that Applicants, by their own admission and without dispute, did not know as of the filing date that the 36%-45% range was the working range is further evidence that, as purely factual matter, Applicants did not contemplate or possess the instantly claimed range of 36%-45%.

Conclusion

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No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric E. Silverman, PhD whose telephone number is 571 272 5549. The examiner can normally be reached on Monday to Friday 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on 571 272 0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Eric E. Silverman, PhD
Art Unit 1618



MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER